

Notice of Allowability

Application No.

09/643,554

Examiner

Luke Gilligan

Applicant(s)

FIEDOTIN ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 4/2/07.
2. ☒ The allowed claim(s) is/are 1 and 3-57.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☒ Interview Summary (PTO-413),
Paper No./Mail Date 20070606.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

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EXAMINER'S AMENDMENT

1. examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.
2. Authorization for this examiner's amendment was given in a telephone interview with Dion Bregman on 6/5/07.

The application has been amended as follows:

At the last line of claim 22, please delete the word "toward" and insert the word "to".

Response to Amendment

3. In the amendments filed 12/7/06 and 3/16/07 (resubmitted on 4/2/07), the following has occurred: claims 1, 6, 12, 17, 18-20, 22, 24, 25, 31, and 35 have been amended and claims 36-57 have been added. Now, claims 1 and 3-57 are presented for examination.

Allowable Subject Matter

4. Claims 1 and 3-57 are allowed. The following is an examiner's statement of reasons for allowance: The primary reason for the allowance of claims 1, 3-30, 37-46, 50, and 52-56 is the inclusion of the limitations in all of the claims which is not found in the prior art of computer monitoring an expiration date of a prescription at a renewal server by periodically determining whether a predetermined time period before the expiration date has been reached, at the

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renewal server, generating a prescription renewal request based on the computer monitoring, transmitting the request from the server to a handheld computing device associated with a prescriber who has authority to authorize a dispenser to dispense the prescription, in response to the request, receiving a renewal prescription at the server from the handheld computing devices, and the server notifying the dispenser, in the form of a pharmacy or a pharmacy benefit management organization, to fill the renewal prescription. The closest prior art (Halvorson, USPN 4,847,764) teaches a method of renewing prescription orders within a hospital by monitoring and expiration date of an order, providing a physician with a notification of an order that is about to expire, and requiring authorization from the physician prior to dispensing a new prescription order (see column 4, lines 28-32, column 5, lines 27-32, and column 10, line 40). However, does not teach performing these steps at a renewal server, transmitting information to a handheld computing device, and notifying a pharmacy or pharmacy benefit management organization to fill the renewal prescription as claimed. Furthermore, it would not have been obvious to one of ordinary skill in the art to modify Halvorson to include such features because the entire design and purpose of Halvorson is directed to managing orders within a hospital for patients within the hospital, rather than being directed to renewing an existing prescription and notifying a pharmacy or PBM to dispense the prescription.

5. Similar to above, the primary reason for the allowance of claims 31-36, 47-49, 51 and 57 is the inclusion of the limitations in all of the claims which is not found in the prior art of calculating at a renewal server a renewal date for a prescription, periodically determining at the server whether the date has been reached, generating at the server a prescription renewal request based on the determining, transmitting the request from the server to a handheld computing device associated with a prescriber who has authority to authorize a dispenser to dispense the prescription, receiving at the server a renewal prescription in response to the

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request, and the server notifying the dispenser, in the form of a pharmacy or PBM to fill the prescription. Again the closest prior art of Halvorson teaches a similar method for processing prescription orders within a hospital, but for the reasons given above, does not teach or suggest the particular combination of recited claim limitations.

6. Additionally, the prior art teaches web-based prescription processing through handheld communication devices (see ReadyScript reference, paragraph 2) as well as suggesting automating of the prescription renewal process (see ReadyScript reference, paragraph 6).

However, the prior art, and ReadyScript in particular, explicitly teach the particular features as described above to carry out the automating of the prescription renewal process. For example, ReadyScript does not teach monitoring an expiration date of a prescription at a renewal server by periodically determining whether a predetermined time period before said expiration date has been reached. Therefore, claims 1 and 3-57 are distinguished over the prior art.

7. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Fillingane teaches an electronic, portable, handheld prescription writing apparatus.


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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke Gilligan whose telephone number is (571) 272-6770. The examiner can normally be reached on Monday-Friday 8am-5:30pm.

10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

6/7/07


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